

REMARKS

Applicant submits this Amendment in reply to the Office Action mailed January 2, 2008. Claims 34-37 and 39-66 are pending in this application, and claims 48-66 have been withdrawn. In this Amendment, Applicant has amended claim 34 to recite "wherein said expanding step includes ... admitting a working fluid between the outer surface of the toroidal support and the inner surface of the tyre while the mould is closed, wherein the working fluid is under a lower pressure than that of the fluid under pressure admitted during the expanding step." (emphasis added.) The originally-filed specification, claims, abstract, and drawings fully support the amendment of claim 34. No new matter has been introduced.

In the Office Action, the Examiner rejected claims 34-37 and 39-47 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 1,407,839 to Clinefelter et al. ("Clinefelter") in view of U.S. Patent No. 4,400,342 to Logan ("Logan"); rejected claims 34-37 and 39-47 under the judicially created doctrine of obviousness-type double patenting over claims 1-19 of U.S. Patent No. 6,479,008 to Caretta ("the '008 patent"); and rejected claims 34-37 and 39-47 under the judicially created doctrine of obviousness-type double patenting over claims 1-10 of U.S. Patent No. 6,332,999 to Caretta ("the '999 patent") in view of Logan. Applicant respectfully traverses the Examiner's rejections for at least the reasons discussed below.

Claim Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of independent claim 34 based on Clinefelter in view of Logan. In the present case, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness because the

Examiner has not shown that Clinefelter in view of Logan whether alone or in combination, either (1) teach all the present claim limitations; (2) suggest a motivation for one of ordinary skill in the art to modify their teachings to make the claimed invention; or (3) provide one of ordinary skill with a reasonable expectation of success in so combining and/or modifying their teachings. See M.P.E.P. §§2143.01, 2143.02, & 2143.03.

Amended claim 34 recites “wherein said expanding step includes a step of admitting a fluid under pressure, and, before the expanding step, admitting a working fluid between the outer surface of the toroidal support and the inner surface of the tyre while the mould is closed, wherein the working fluid is under a lower pressure than that of the fluid under pressure admitted during the expanding step.” (emphasis added.) Neither Clinefelter nor Logan disclose this feature.

In column 4, lines 5-15, Clinefelter teaches placing the tyre in a vulcanization mould and immediately thereafter passing pressurized fluid through an aperture in order to expand the tyre. Clinefelter is entirely silent as to the claimed method “wherein said expanding step includes a step of admitting a fluid under pressure, and, before the expanding step, admitting a working fluid between the outer surface of the toroidal support and the inner surface of the tyre while the mould is closed, wherein the working fluid is under a lower pressure than that of the fluid under pressure admitted during the expanding step.” Accordingly, the Examiner specifically acknowledged that Clinefelter does not show the admission of a working fluid at a lower pressure than that of the fluid under pressure admitted during the expanding step. (Office Action at pg. 2.)

The Examiner then contends that Logan teaches this step. (*Id.*) While Logan teaches the “flow of low pressure media,” it teaches this step specifically while the mould remains open (Logan at column 2, lines 10-11), unlike the claimed invention. It is improper to combine references where the references teach away from the claimed combination. M.P.E.P. § 2145(X)(D). In this application, Logan teaches away from the claimed combination due to the fact that it specifically requires that the mould be open during the admission of the low pressure in order to center the tyre. (See Fig. 4; column 4, lines 1-22.) Logan therefore, fails to cure the above-identified deficiencies of Clinefelter, and claim 34 is allowable over Clinefelter in view of Logan.

Claims 35-37 and 39-47 depend directly or indirectly from independent claim 34, and are therefore allowable for at least the same reasons stated above regarding claim 34. In addition, each of these dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

Claim Rejections Under Obviousness-Type Double Patenting

While Applicant does not concede the propriety of the obviousness-type double patenting rejections, solely in the interests of expediting the prosecution of this application, Applicant submits two separate Terminal Disclaimers herewith. The submission of the Terminal Disclaimers in no way manifests an admission by Applicant as to the propriety of the double patenting rejection set forth in the Office Action. Nor does Applicant subscribe to the various characterizations and assertions regarding the claims set forth in that double patenting rejection. See M.P.E.P. § 804.02 (citing *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d

1392 (Fed. Cir. 1991) ("In legal principle, the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection")). In view of the Terminal Disclaimer, Applicant respectfully requests withdrawal of the double patenting rejection and allowance of the pending claims.

Claim Scope

In discussing the specification, claims, abstract, and drawings in this Amendment, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicant believes that Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Summary

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this Application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 26, 2008

By: 

Meredith H. Schoenfeld
Reg. No. 52, 418